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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,290	11/30/2001	Kazuaki Kidokoro	016887-1054	2651
22428	7590	09/08/2005	EXAMINER	
FOLEY AND LARDNER				HANG, VU B
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				2622

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/997,290	KIDOKORO ET AL.	
Examiner	Art Unit		
Vu B. Hang	2622		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 30 November 2001.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-17 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 30 November 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other. \_\_\_\_\_ .

***Information Disclosure Statement***

The information disclosure statement filed 11/30/2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Information Disclosure Statement, including PTO-1449 is missing. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C (1).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 7, 8, 10, 14, 15, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomat (US Patent 6,459,499 B1).

Regarding **Claims 1 and 8**, Tomat discloses an image reading system (see Fig.1 and Fig.2) comprising: a client terminal device which comprises an image display which has predetermined image display capability and displays an image (see Fig.1 (10) and

Col.2, Line 11-17), and a transfer unit for transferring information concerning the capability (see Fig.2 (33) and Col.4, Line 51-52), and an image reading apparatus which comprises an image processing content determinator for receiving the information concerning the capability transferred from the transfer unit, and determining the capability of the client terminal device (see Fig.2 (15) and Col.2, Line 46-51), an image reader for reading an image to generate first image data (see Fig.2 (1)), an image processor for performing , on the first time image data, image processing corresponding to the capability determined by the image processing content determinator, and generating second image data (see Fig.2 (15,49,50) and Col.2, Line 46-56), and an image data transfer unit for transferring the second image data to the client terminal device (see Fig.2 (46,47) and Col.2, Line 54-56).

Regarding **Claims 3 and 10**, Tomat discloses that the client terminal device transfers, to the image reading apparatus, information indicating whether the image display is monochromatic or color display (see Fig.5 (122) and Col.8, Line 35-39), and if it is color display, information concerning the color depth will be transferred as information concerning capability (see Col.8, Line 35-39). Tomat also discloses that the image reading apparatus generates the second image data by performing, on the first image data, color/monochromatic conversion (see Fig.5, (122), Fig.6 (149) and Col.2, Line 46-56) and if the image display is a color display, color depth conversion, in accordance with the information (see Col.8, Line 35-39).

Regarding **Claim 7**, Tomat discloses an image reading system (see Fig.1 and Fig.2) comprising: a client terminal device which comprises an image display which has predetermined image display capability and displays an image (see Fig.1 (10) and Col.4,

Line 26-31), and a transfer unit for transferring information concerning the capability and information concerning a destination of first image data (Fig.1 (15), Fig.2 (47) and Col.5, Line 21-23); an image processing content determinator for receiving the information concerning the capability transferred from the transfer unit, and determining the capability of the client terminal device (see Fig.2 (15) and Col.2, Line 46-51); an image reader for reading an image to generate the first image data (see Fig.2 (1)); an image processor for performing, on the first image data, image processing corresponding to the capability determined by the image processing content determinator, and generating second image data (see Fig.2 (15) and Col.2, Line 46-56); and an image transfer unit for transferring the second image data to the client terminal via a network, and transferring the first image data to the transfer destination of the first image data via the network (see Fig.2 (47) and Col.2, Line 46-56).

Regarding **Claim 14**, Tomat discloses a program for causing a client terminal device and an image processing apparatus to perform processing necessary for image reading (see Col.2, Line 11-16), which causes: a client terminal device to transfer information concerning a capability of an image display to the image processing apparatus (see Col.2, Line 11-16); the image processing apparatus to determine the capability of the client terminal device by using the transferred information concerning the capability (see Col.2, Line16-21); generate first image data by reading an image (see Fig.2 (1)), perform image processing corresponding to the determined capability for the first image data, and generating second image data; and transfer the second image data to the client terminal device (see Col.2, Line16-21); and the client terminal device to display on the image display by using the transferred second image data (see Fig.2 (10,33)).

Regarding **Claim 15**, Tomat discloses an image reading program for causing a client terminal device to perform processing necessary for image reading (see Col.2, Line 11-17), which causes the client terminal to apparatus to: transfer information concerning a capability of an image display to an image processing apparatus (see Col.2, line 11-17); and display an image on the image display by using the image data that the image processing apparatus generates by reading an image and performing image processing corresponding to the capability (see Col.2, Line 18-21), and transfers to the client terminal device (see Col.2, Line 18-21).

Regarding **Claim 16**, Tomat discloses an image reading program for causing an image processing apparatus to perform processing necessary for image reading (see Col.2, Line 11-17), which causes the image processing apparatus to: determine a capability of a client terminal device by using information which is transferred by the client terminal device and concerns the capability of an image display (see Col.2, Line 46-51); generate first image data by reading an image (see Col.2, Line 51-54), perform image processing corresponding to the determined capability on the first image data (see Col.2, Line 51-54), and generating second image data (see Col.2, Line 51-54); and transfer the generated second image data to the client terminal device (see Col.2, Line 54-56).

Regarding **Claim 17**, Tomat discloses an image reading apparatus (see Fig.2) comprising: an image processing content determinator for receiving information concerning a capability of an image display from a client terminal device having the image display (see Fig.2 (50) and Col.2, Line 33-41), and determining the capability of the client terminal device (see Col.2, Line 46-51); an image reader for reading an image

to generate first image data (see Fig.2 (1) and Col.2, Line 51-54); an image processor for performing, on the first image data, image processing corresponding to the capability determined by the image processing content determinator (see Col.2, Line 51-54), and generating second image data (see Col.2, Line 51-54); and an image transfer unit for transferring the second image data to the client terminal device (see Fig.2 (47) and Col.2, Line 54-56).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 4, 5, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat (US Patent 6,459,499 B1) in view of Kajita et al. (US Patent 6,069,706).

Regarding **Claims 2 and 9**, Tomat discloses the image reading system described in Claim 1 but fails to expressly disclose the transfer of information concerning the image size of the image display as the information concerning the capability, and the image reading apparatus generates the second image data by enlarging or reducing the first image data in accordance with the information. Kajita, however, discloses the image size information (see Col.6, Line23-25) as well as having the image reading apparatus either enlarge or reduce the image data in response to the size information (see Col.7, Line 49-51).

Tomat and Kajita are combinable because they are from the same field of endeavor, namely image reading systems. At the time of the invention, it would have been obvious for one skilled in the art to include the image size information as part of the predefined device profile information and having the image reading apparatus to resize the image data based on the image size information. As known in the art, client devices tend to have different displaying capabilities and it is obvious that one of the capabilities deals with image size. It is also known the art that image sizes can be manipulated at either the remote client computer or at the image reading apparatus.

Regarding **Claims 4 and 11**, Tomat discloses the image reading system described in Claim 1 above but Tomat fails to expressly disclose information concerning the capacity of buffer memory as information concerning the capability of the client terminal device, and generating second image data by performing processing on the first image data, based on the memory capacity information. Kajita, however, further discloses the image buffer display memory capacity information of an image display device as the capability information for the device (see Col.6, Line 28-32).

Tomat and Kajita are combinable because they are from the same field of endeavor, namely image reading systems. At the time of the invention it would have been obvious for one skilled in the art to include the display buffer memory capacity information as information concerning the capability of the client terminal device. It is known in the art that image display devices contain display buffer memory. Therefore, the information concerning the buffer memory capacity would allow the image reading system to determine if the processed image data can be transferred to the terminal device. A terminal device with a buffer memory capacity less than the image data size would not

be able to store the image data being transferred. Therefore, it is obvious to include the image display buffer memory capacity information as the capability information for the client terminal device.

Regarding **Claims 5 and 12**, Tomat discloses the image reading system described in Claim 1 above but Tomat fails to expressly disclose information concerning the image data file size as information concerning the capability of the terminal device, and generating second image data by performing processing on the first image data, based on the image data file size information. Kajita, however, further discloses information concerning the image data file size in the image display (see Col.6, Line 28-32).

Tomat and Kajita are combinable because they are from the same field of endeavor, namely image reading systems. At the time of the invention it would have been obvious for one skilled in the art to include the image data file size information as information concerning the capability of the client terminal device. It is known in the art that the image data file size must meet certain requirements for the image display device. This information is necessary since conversion of the image data file into specific format (i.e. JPEG) requires file size information. Therefore, it is obvious to include the image data file size information as the capability information for the client terminal device.

Claims 6 and 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat (US Patent 6,459,499 B1) in view of Ikeda et al. (US Patent 5,720,014).

Regarding **Claim 6 and 13**, Tomat discloses the image reading system described in Claim 1 above but fail to expressly disclose information indicating whether the image display can display information other than characters, as information concerning the capability of the client terminal device, and the OCR processing on the first data if the

information indicates that the display cannot display information other than characters.

Ikeda, however, discloses the OCR processing on the image data by the image reading system (see Col.26, Line 55-60).

Tomat and Ikeda are combinable because they are from the same field of endeavor, namely image reading systems. At the time of the invention, it would have been obvious for one skilled in the art to include information indicating whether the image display can display information other than characters, and perform OCR processing on the data if the information indicates that only characters can be displayed, to the system described in Claim 1. It is known in the art that terminal devices with image displays have certain levels of display capabilities. The image display may display picture data, moving image data or just character data. When only character data are being displayed, it is necessary to run the OCR process to allow the data to be analyzed and be converted to another data, such as ASCII data. The data conversion would allow the user at the client terminal to perform functions on the character display, such as performing text searches. Therefore, it is obvious to include the client display information and the OCR process to the image reading system described in Claim 1.

#### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 14, 15 and 16** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14, 15 and 16 are drawn to

non-functional descriptive material. MPEP 2106.IV.B.1 (a) (Nonfunctional Descriptive Material) states:

“Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101.”

“Where certain types of descriptive material, such as music, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing process performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer.”

“For example, music is commonly sold to consumers in the form of a compact disc. In such cases, the know compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.”

MPEP 2106.IV.B.1 (Nonstatutory Subject Matter) states:

“When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement”.

**Claims 14, 15 and 16** currently recite “computer programs”. There is no functional relationship imparted by this data to a computing device. Therefore, the claim is drawn to non-functional descriptive material, which is non-statutory per se. The fact that the claim recites a computer readable medium does not provide the utility (i.e., practical application in the technological arts) required under 35 U.S.C. 101 for the manufacture.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vu Hang  
Assistant Examiner

*Vu Hang* 08/24/2005

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